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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,042	04/13/2004	Vlad Pigin	683492-0009	4104

25094 7590 10/03/2007
DLA PIPER RUDNICK GRAY CARY US, LLP
2000 University Avenue
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EXAMINER

DINH, MINH

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,042	Applicant(s) IGIN, VLAD	
	Examiner Minh Dinh	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 68) 1) ☒ Responsive to communication(s) filed on 4/13/2004
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/06, 5/26/06, 4/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 have been examined.

Specification

2. The abstract of the disclosure is objected to because it fails to include a concise statement of a technical disclosure of the improvement in an old method and system. Correction is required.

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;

(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a

gap between the steps. See MPEP § 2172.01. The omitted steps are: (i) encrypting the set of recipient rights for the document, and (ii) sending the encrypted set of recipient rights for the document with the encrypted document to the recipient (Specification, paragraphs 0070, 0075-0078).

Without being encrypted, the set of recipient rights could be accessed and/or modified in an unauthorized manner. Without being transmitted with the document to the recipient, the set of recipient rights could not be utilized for digital rights management (DRM) of the document at the recipient's

computer. Claims 8 and 15 are rejected on the same basis as claim 1.

Claims that are not specifically addressed are rejected by virtue of their dependency.

6. Claims 3-4, 10-11 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "wherein the encrypting the document includes utilizing the terminal of the recipient to establish a computer passport". The encryption of the document and the recipient's computer passport are two essential elements of the invention and used together to implement digital rights management (DRM) of the document at the recipient's computer, i.e., a unique symmetric key is generated from the recipient's computer passport, and the symmetric key is used to encrypt the session key, which is used to encrypt the document, and the set of recipient rights to the document (Specification, paragraphs 0040, 0070, 0075-0080). However, the claim fails to interrelate these essential elements of the invention as defined by Applicant; specifically, the claim fails to recite how the computer passport is utilized in the method. Therefore, claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (See MPEP 2172.01). Claims 10 and 16 are rejected on the same basis as claim 3. Claims that are not specifically addressed are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Knaft (US 2001/0029581 A1). Knaft discloses a method and system for sending an encrypted data object such as a text, audio, video, image or multimedia file from a sender (i.e., a server) to a recipient (i.e., a user) (Abstract, paragraph 0005). A broad and reasonable interpretation of a document includes the data object of Clark.

Regarding claims 1-2 and 15, Knaft specifically discloses a method comprising:

selecting a document to encrypt and send to the recipient, i.e., selecting a data object for secure packaging in response to a user request (Fig. 4B; element 106; paragraphs 0031);

selecting a set of recipient rights, i.e., control elements, for the document including viewing/printing rights and the duration of use (Fig. 6B; Fig. 7A, step 714; paragraph 0097);

encrypting the document (Fig. 4B, element 414; Fig. 5A, step 502); sending the encrypted document from the sender to the recipient (Fig. 5A, step 514);

receiving the encrypted document at a terminal of the recipient (Fig. 5B, step 522); and

accessing the document according to the set of recipient rights (Fig. 7B, step 734; paragraphs 0097, 0107).

Regarding claims 3-4 and 16-17, Knauft further discloses utilizing the terminal of the recipient to establish a computer passport (i.e., generating a certificate certifying a public machine key being the MAC address of the terminal of the recipient) and using the computer passport in the encryption process (i.e., encrypting the session key, which is used to encrypt the document, with the public machine key) (Fig. 3A, elements 118-119; Fig. 4B, element 420; Fig. 5A, step 512; paragraphs 0051-0052, 0054, 0075).

9. Claims 1-2, 5, 8-9, 12, 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanungo et al. (US 2005/0120212 A1). Kanungo discloses a system and method for a sender to control a document sent to a recipient in manner that (1) encrypts the document, and (2) restricts operations the recipient may perform on the received document (Abstract).

Regarding claims 1-2, 8-9 and 15, Kanungo specifically discloses a method comprising:

selecting a document (i.e., an e-mail) to encrypt and send to the recipient (Fig. 1, step 102; Fig. 10, element 1000);

selecting a set of recipient rights for the document (Fig. 4);

encrypting the document (Fig. 1, step 110);

sending the encrypted document from the sender to the recipient (Fig. 1, step 114);

receiving the encrypted document at a terminal of the recipient (Fig. 1, step 114); and

accessing the document according to the set of recipient rights (Fig. 4).

Regarding claims 5, 12 and 18, Kanungo further discloses using a certificate of the sender (Fig. 1, step 112).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-4, 10-11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanungo as applied to claims 1, 8 and 15 above, and further in view of Knauft. Kanungo discloses utilizing data specific to the recipient (i.e., the recipient's public key) in encrypting the document so that only the recipient can decrypt the document (Fig. 1, step 110; Fig. 9, steps 912, 914 and 920). Kanungo does not disclose utilizing data specific to the recipient's terminal, such as a computer passport of the recipient's terminal, in encrypting the document. Knauft discloses a method for encrypting a document, which utilizes both the recipient's public key and a computer passport of the recipient's terminal (i.e., a certificate certifying a public key being the MAC address of the terminal of the recipient) (Fig. 3A, elements 118-121; Fig. 4B, elements 418 and 420; Fig. 5A; paragraphs 0051-0052, 0054, 0072-0075). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system of Kanungo to utilize a computer passport of the

recipient's terminal, in addition to the recipient's public key, in encrypting the document, as taught by Knauft. The motivation for doing so would have been to control not only who but also which terminal can access the document (paragraph 0011).

12. Claims 6, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanungo. Kanungo discloses using a certificate of the sender in the encryption process (Fig. 1, step 112). Kanungo fails to disclose that the certificate is selected from a set of certificates of the sender, i.e. the sender has more than one certificate. Official Notice is taken that both concept and advantage of an entity owning/having multiple certificates are well known and expected in the art. It would have been obvious to modify the method and system of Kanungo such that the sender has a multiple certificates, each of which could be used in a certain domain or for a certain purpose.

13. Claims 7, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanungo as applied to claims 1, 8 and 15 above, and further in view of Leonard et al. (US 7,149,893 B1). Kanungo does not disclose selecting a document to wipe out completely from any storage device. Leonard discloses a method and system for sending emails wherein

the sender of an email can select a date, time or event at which the email and all copies of the email are wiped out (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system of Kanungo such that the sender could select a document to wipe out completely from any storage device, as taught by Leonard. The sender might control the lifespan of the document, so that the message and all copies of the message anywhere disappear at the appropriate time (col. 7, lines 19-23).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,289,450 to Pensak et al.

U.S. Patent No. 6,721,784 to Leonard et al.

U.S. Patent No. 7,143,296 to Hirata

U.S. Patent App. Publication No. 2002/0129275 to Decuir

"Authentica Unveils Saferoute for Secure Messaging"

Ford et al, "A Key Distribution Method for Object-Based Protection"

Bott et al, "Microsoft Windows Security Inside Out"

Microsoft Computer Dictionary

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/MD/
Minh Dinh
Examiner
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